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IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

PAUL M. AMBROSE AND CRIMORA RESEARCH AND DEVELOPMENT CORPORATION, *Petitioners*,

v.

JOHN A. MARZALL, Commissioner of Patents, *Respondent*.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT AND BRIEF IN SUPPORT THEREOF.

ALVA D. ADAMS,
STONE E. BUSH,
Counsel for Petitioners.

Dated: Washington, D. C.
May 5, 1950.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

To the Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioners, Paul M. Ambrose and Crimora Research and Development Corporation, pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, entered herein on February 6, 1950 (R. 61).

Summary Statement of the Matter Involved.

This is a suit in equity brought by petitioners against the Commissioner of Patents of the United States, the respondent, demanding that he be required to reissue Ambrose Patent No. 2,347,451, granted on April 25, 1944 (R. 55), containing the three claims at bar (R. 33), based upon the Ambrose invention on Electrodeposition of Manganese.

An application, Serial No. 568,310 (R. 29), for reissue of said patent was regularly filed by Paul M. Ambrose on De-

cember 15, 1944, within less than a year after the original patent was granted. The reissue application was duly prosecuted before the Patent Office, and the claims here in issue, were finally rejected by the Examiner, and, upon appeal to the Board of Appeals of the Patent Office, the decision of the Examiner was affirmed on October 1, 1946 (R. 43). On petition for a re-hearing the Board of Appeals reaffirmed its decision on October 31, 1946 (R. 46).

As a result of the adverse decision of the Board of Appeals, petitioners filed a bill of complaint under the provisions of R. S. Sec. 4915, in the District Court of the United States for the District of Columbia (R. 46).

Respondent, in his answer (R. 6), denied that petitioners were lawfully entitled to a reissue of said Ambrose patent containing the claims at bar, on the ground of estoppel, stating that Ambrose had cancelled similar claims 4 and 9 in his original application for said patent (R. 57).

At the trial in the District Court, petitioners took the testimony of one expert witness (excerpts, R. 11) to explain the nature of the improvement covered by the claims at bar and to show how they distinguish from the two cancelled claims, 4 and 9, in the original application relied upon by respondent as constituting the alleged estoppel.

The Trial Court found that cancelled claims 4 and 9 in the original Ambrose application, when taken together, contained substantially the same subject matter as that sought in the claims at bar; that the abandonment of those claims constituted estoppel; and that it is of no importance that the subject matter of the claims sought in the reissue was not entirely contained in a single abandoned claim (R. 8).

On appeal to the Court of Appeals for the District of Columbia Circuit the decision of the District Court was affirmed (R. 61) and the Court stated in its opinion:

> "Quite apart from any question of estoppel, there was no substantial evidence of inadvertence, accident or mistake required by R. S. § 4916, 35 U.S.C. § 64," (R. 60)

The invention described in the original application for the Ambrose patent sought to be reissued relates to the electrolytic recovery of manganese and has particular reference to the purification of an aqueous manganese electrolyte solution from which the pure metal is to be obtained. The essence of the process is the addition of a very small amount of material providing a sulphide ion to effect precipitation of traces of nickel and cobalt present in the solution. The pH of this solution is maintained between 5.5 and 8.5 when the sulphide ion is added. The amount of the sulphide ion is just sufficient to remove the nickel and cobalt by first forming a pink manganese sulphide and then permitting the solution to stand long enough for the pink sulphide to react with the nickel and cobalt and form a black precipitate containing all of the nickel and cobalt. The solution is then filtered to remove the precipitate.

The reissue claims at bar, are in method form. Claim 19 is considered illustrative by all the parties and reads as follows:

> 19. That method of purifying an aqueous manganese sulphate-ammonium sulphate solution containing traces of nickel and cobalt, preparatory to electrolytic recovery of manganese from the purified solution, which is characterized by adding to the solution, at a pH between about 5.5 and about 8.5, sulphide ion in an amount not in excess of 1 percent of the stoichiometric equivalent of the manganese present and sufficient to remove the nickel and cobalt, to form pink manganese sulphide; reacting the pink sulphide with the nickel and cobalt compounds in the solution long enough for the pink sulphide to undergo a change and form a black precipitate containing substantially all of the nickel and cobalt; and then filtering the solution to remove said precipitate.

The Question Presented.

Is the abandonment of two separate and distinct claims in an original application, which claims taken together, contain substantially the same subject matter as claims sought

in a reissue of the patent, conclusive that there was no "inadvertence, accident or mistake" within the meaning of R. S. Sec. 4916?

Reasons for Granting the Writ.

The decision of the Court of Appeals affirming the Trial Court's holding that:

> "In considering the right of a reissue applicant to obtain claims for subject matter substantially the same as that of claims abandoned in his original application, it is of no importance that the subject matter of the claims sought in the reissue was not entirely contained in a single abandoned claim, and that the subject matter abandoned was presented in more than one claim."

is not supported by any decision of this Court or any other Federal Court.

If this rule of law is permitted to prevail, it will jeopardize the validity of every unexpired reissue patent containing claims to subject matter which might be found in a plurality of abandoned claims made in the original application, even though the same subject matter is not contained in any one of the abandoned claims. Moreover, it will seriously affect the rights, granted by the Reissue Statute, of all future inventors who may seek to reissue their patents.

This rule is an unduly restricted interpretation of the Reissue Statute. It goes beyond any interpretation of the Reissue Statute heretofore made by this Court, and should not be permitted to stand.

Wherefore, it is respectfully submitted that this petition for a writ of certiorari to the United States Court of Appeals for the District of Columbia Circuit should be granted.

ALVA D. ADAMS,
STONE E. BUSH,
Counsel for Petitioners.

Dated: Washington, D. C.
May 5, 1950.

IN THE

Supreme Court of the United States

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PAUL M. AMBROSE AND CRIMORA RESEARCH AND DEVELOPMENT CORPORATION, *Petitioners*,

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JOHN A. MARZALL, Commissioner of Patents, *Respondent*.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of Courts Below.

OPINION OF DISTRICT COURT (R. 8)

"Plaintiff abandoned claims to substantially the same subject matter in the Patent Office as are here sought. Plaintiffs are estopped to claim such subject matter. It is of no importance that the subject matter abandoned was presented in more than one claim. The claims at bar are unpatentable to plaintiffs in an application for re-issue. The complaint will be dismissed.

Counsel for defendant will submit an appropriate order.

F. DICKINSON LETTS,
Justice."

OPINION OF COURT OF APPEALS (R. 60)

"PER CURIAM: This appeal is from a judgment for the defendant Commissioner of Patents in a suit

under R. S. § 4915, 35 U. S. C. § 63, to obtain reissue of a patent with added claims. Quite apart from any question of estoppel, there was no substantial evidence of the 'inadvertence, accident or mistake' required by R. S. § 4916, 35 U. S. § 64. We express no opinion regarding the District Court's ruling that the appellant was, as a matter of law, estopped to make the added claims.

Affirmed."

Jurisdiction.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U.S.C.A. 347). The judgment of the Circuit Court of Appeals for the District of Columbia Circuit was entered on February 6, 1950 (R. 61).

Statutes Involved.

R. S. Sec. 4915, authorizing this suit and R. S. Sec. 4916, authorizing reissues of patents are printed in the appendix to the brief.

Statement of Case.

The essential facts of the case are stated in the petition.

Specification of Errors.

The error which petitioners will urge, if the writ of certiorari is issued, is that the Court of Appeals for the District of Columbia Circuit erred:

(1) In holding that there was no substantial evidence of inadvertence, accident or mistake, as required by R. S. Sec. 4916, which would warrant the grant of a reissue of the Ambrose patent No. 2,347,451 with the claims at bar.

(2) In affirming the judgment of the District Court.

(3) In not directing that the Commissioner of Patents be required to reissue the Ambrose patent with the claims at bar.

Summary of Argument.

We respectfully show herewith that the record of this case discloses such evidence of inadvertence, accident or mistake, as to justify the grant of a reissue patent containing the claims at bar.

We shall show that the scope and intent of the Reissue Statute would be unduly limited and restricted beyond any interpretation heretofore expressed by this Court, if the rule of law set forth in the decisions of the Courts below is permitted to stand.

Argument.

The sole issue is one of law, involving the interpretation of the Reissue Statute (R. S. Sec. 4916). The question is whether the Commissioner of Patents is justified in refusing to grant a reissue patent containing a claim, the subject matter of which is substantially the same as that contained in a plurality of claims, when taken together, which claims were abandoned in the applicant's original application.

Petitioners freely admit that an applicant for a reissue is not entitled to recapture the subject matter of a claim which had been abandoned in his original application. The law on this point is clearly stated in *Leggett v. Avery*, 101 U. S. 256, as follows:

> "... it is extremely doubtful whether reissued letters can be sustained in any case where they contain claims that have once been formally disclaimed by the patentee, or rejected with his acquiescence, and he has consented to such rejection in order to obtain his letters patent. Under such circumstances, the rejection of the claims can in no sense be regarded as a matter of inadvertence or mistake. Even though it was such, the applicant should seem to be estopped from setting it up on an application for a reissue." (p. 259)

However, it is petitioners' contention that this rule of law should not be extended to permit the combining of the subject matter of a plurality of separate and distinct, aban-

doned claims to establish such lack of "inadvertence or mistake" as to prevent the grant of a reissue containing a claim which includes the combined subject matter of the separate, abandoned claims.

In the instant case, the Commissioner of Patents rejected the claims at bar on the ground of estoppel, holding that abandoned claims 4 and 9 in the original Ambrose application, when taken together, contain substantially the same subject matter as the reissue claims at bar. In its decision affirming the Commissioner, the District Court included the following finding, upon which its decision was based, viz:

> "The abandonment of claims 4 and 9 in the application which resulted in the Ambrose Patent No. 2,347,451, which claims taken together contained substantially the same subject matter as that sought in claims 19, 20 and 21 at bar, is conclusive that there was no inadvertence, accident or mistake within the meaning of Section 4916 Rev. Stat." (R. 9)

The Court of Appeals, while choosing to ignore the "question of estoppel", unquestionably based its decision upon the foregoing finding by holding that:

> "—there was no substantial evidence of the inadvertence, accident or mistake required by R. S. § 4916, 35 U.S.C. § 64". (R. 60)

The "inadvertence, accident or mistake" relied upon by Ambrose in his reissue application to justify the reissue of his patent was the failure of his former solicitor to present claims in his original application commensurate with the invention, such as the claims at bar (R. 32, 33).

The general rule relating to inadvertence, accident or mistake was laid down by this Court in *Topliff* v. *Topliff*, 145 U.S. 156, wherein the Court stated:

> "The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced

persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention, provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it, and no third persons have in the meantime acquired the right to manufacture or sell what he had failed to claim. The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation." (p. 171)

The above interpretation of the statute was followed by the Circuit Courts of Appeal for the 3rd, 6th and 7th Circuits in the following cases:

Robert v. *Krementz,* 243 Fed. 877 (C.C.A. 3);
Van Kannel Revolving Door Co. v. *Winton Hotel Co.,* 276 Fed. 234 (C.C.A. 6); and
Moneyweight Scale Co. v. *Toledo Computing Scale Co.,* 187 Fed. 826 (C.C.A. 7)

In the *Robert* v. *Krementz* case, the Court stated:

"It has been generally held that inability of solicitors for a patentee to put claims into a form that covers the real invention constitutes a case of inadvertence authorizing a reissue, and in such case the abandonment of such claims or their rejection by the Patent Office is not an abandonment of the invention and does not preclude a reissue and the substitution of claims which properly cover it." (pp. 881-2)

Petitioners contend that the Court of Appeals in this case has improperly and unjustly restricted the applica-

tion of the foregoing rule, by affirming the District Court in its conclusion of law that:

> "In considering the right of a reissue applicant to obtain claims for subject matter substantially the same as that of claims abandoned in his original application, it is of no importance that the subject matter of the claims sought in the reissue was not entirely contained in a single abandoned claim, and that the subject matter abandoned was presented in more than one claim." (R. 10)

In the *Moneyweight Scale* case, *supra,* the Court in sustaining a reissue patent, stated:

> "We have examined each of the twenty-seven rejected claims and have failed to find one that would be adequate to secure a monopoly of the DeVilbiss computing scale that would cover 'the details of construction' in which the invention as an entirety resided." (p. 830)

It is significant that the Court considered twenty-seven claims, which were abandoned in the original application, but did not find that a single one of them set forth the subject matter of the reissue claims. Petitioners submit that had the Court followed the rule adopted by the Court of Appeals in the instant case, by combining limitations found in any combination of the twenty-seven claims, it is almost certain that all of the subject matter of the reissue claims would have been found in them and the reissue patent would have been held to be invalid.

In the instant case, one of the abandoned claims, claim 4, was rejected by the Patent Office Examiner as being both "incomplete" and "indefinite" (R. 51) in failing to recite a critical step of the method and in failing to define the amount and kind of metals present in the solution to be treated. In addition to the impropriety of combining separate abandoned claims to establish lack of "inadvertence, accident, or mistake", it is submitted that an admittedly incomplete and indefinite claim should not be considered in this connection. If this is permitted, all

patentees whose attorneys originally seek and cancel such indefinite claims as those reciting the invention (naming it) "substantially as shown and described" would be deprived of their rights to reissue their patents.

Conclusion.

For all of the foregoing reasons, it is respectfully submitted that petition for a writ of certiorari should be granted.

Respectfully submitted

ALVA D. ADAMS,
STONE E. BUSH,
Counsel for Petitioners.

APPENDIX.

R. S. Sec. 4915, 35 USCA 63.

63. BILL IN EQUITY TO OBTAIN PATENT.

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit."

R. S. Sec. 4916, 35 USCA 64.

"64. REISSUE OF DEFECTIVE PATENTS; PATENTS FOR SEPARATE PARTS.

"Whenever any patent is wholly or party inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own

invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specification and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid."